

RECEIVED
CENTRAL FAX CENTER

OCT 03 2006

Serial No. 10/766,088

Page 7

REMARKS

Claims 1-3, 5, 6, 9, 11-14, 16, 17, 19, 21, and 23-26 are pending in this application of which claims 2, 3, 13, 14, 16, 17, 19, 21, and 25 are withdrawn. By this Amendment, claim 23 is amended and claim 24 is canceled. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

Initially, Applicant traverses the finality of the Office Action because it introduces a new ground of rejection that was not necessitated by Applicant's amendment. In particular, MPEP § 706.07(a) expressly states "...Second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is [not] necessitated by applicant's amendment of the claims..." The Office Action introduces a new ground of rejection of claim 1. However, claim 1 already existed as claim 4 at the time of the first Office Action. More particularly, claim 1 is the verbatim recitation of original claim 4 in independent form, as clearly indicated on page 4 of the previous Amendment. Claim 4 was originally rejected under 35 U.S.C. § 102 over Kim et al. (U.S. Patent No. 6,254,249). Claim 1 is now rejected under 35 U.S.C. § 103 over Kim et al. and Leman (U.S. Patent No. 6,161,944), which is a new ground of rejection. Because no amendments were made to claim 4 when it was rewritten in independent form as claim 1, the new ground of rejection was not necessitated by Applicant's amendment, as required by MPEP § 706.07(a). Accordingly, Applicant requests the withdrawal of the finality of the Office Action.

The Office Action rejects, under 35 U.S.C. § 102, claim 23 over Leman. The Office Action also rejects, under 35 U.S.C. § 103, claim 1, 5, 11, 23, 24, and 26 over Kim et al. and Leman, claims 6 and 12 over Kim et al., Leman, and Hsu (U.S. Patent Pub. No. 2002/0177467), and claim 9 over Kim et al., Leman, and Motegi (U.S. Patent Pub. No. 2003/0107554). These rejections are respectfully traversed.

Applicants assert the Office Action has not provided proper motivation to combine Leman and Kim et al.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference or in the knowledge

Serial No. 10/766,088

Page 8

generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure (MPEP 2142). The prior art must suggest the desirability of the claimed invention (MPEP 2143.01).

The Office Action alleges "coupling the light source to the second housing would have been an obvious rearrangement of location of parts to one of ordinary skill in the art."

Applicants disagree.

Applicants assert the Office Action has not provided a proper basis for alleging the claimed elements "would have been an obvious rearrangement of location of parts." In particular, the Office Action cites *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). However, the court in *In re Harza* only held court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. Applicants assert *In re Harza* is inapplicable because the Office Action is attempting to support its allegation of rearrangement of parts, not the duplication of parts. Thus, the Office Action has not provided a proper basis for citing the claimed elements "would have been an obvious rearrangement of location of parts."

The Office Action goes on to allege, "Kim contemplated changes and modification to the design." The Office Action goes on to support this allegation by citing col. 2, lines 36-44, which state in part, "various changes and modifications can be embodiment to include at least one lamp."

Applicants assert the cited section does not provide proper motivation to modify Kim to obtain the claimed invention. Initially, Applicants assert the cited sentence does not make any sense. In particular, the sentence section, "various changes and modifications can be embodiment to include at least one lamp" does not include a proper verb. Thus, the cited sentence would not make sense to one of ordinary skill in the art.

Furthermore, the cited section would only suggest that a modification can be done. However, this is an insufficient ground to support motivation to modify the teachings of Kim to

Serial No. 10/766,088

Page 9

achieve the claimed invention. It is insufficient because it does not teach modifying Kim to achieve the specific elements in claim 1. It is further insufficient because "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01(III) citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Thus, the cited section does not provide proper motivation to modify Kim to obtain the claimed invention.

The Office Action then alleges "merely shifting the light sources does not constitute novelty." Applicants disagree. Applicants assert, by definition, any difference between the claimed invention and the cited reference constitutes "novelty."

Furthermore, Applicants assert "the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims... is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). The Office Action has not provided any motivation to make the necessary changes.

The Office Action goes on to cite Leman "to provide further evidence that light source can be related between a first and second housing." The Office Action alleges motivation is based on Leman, col. 1, lines 20-21, which state, "it would be beneficial to provide improved keyboard illumination." Applicants disagree.

Applicants assert the cited section does not provide proper motivation to combine the teachings of Leman with the teachings of Kim et al. In particular, the cited section is only discussed in the context of laptop computer systems (col. 1, lines 9-21). The cited section does not disclose any benefits to the cellular phone of Kim et al. (Title, col. 1, line 7). Thus, the cited section does not provide proper motivation to combine the teachings of Leman with the teachings of Kim et al.

Serial No. 10/766,088

Page 10

The Office Action also alleges motivation is based on col. 3, lines 17-19, which state, "the illumination device should not obstruct the normal operation of the computer system because of the location and the retractable feature of the device." Applicants disagree.

Applicants assert the cited section does not provide proper motivation to combine the teachings of Leman with the teachings of Kim et al. In particular, the cited section only discloses a benefit for a computer system. The cited section does not disclose any benefits to the cellular phone of Kim et al. (Title, col. 1, line 7). Furthermore, the cited section only discloses the benefit of the retractable feature of the device, it does not disclose a benefit to coupling a light source to a second housing. Thus, the cited section does not provide proper motivation to combine the teachings of Leman with the teachings of Kim et al.

Applicants further assert Leman and Kim do not disclose a light source configured to direct light substantially directly at an external visible portion of a mobile communication device numeric keypad when a second housing is in the open position and second housing hinge section configured to expose the light source external to the mobile communication device when a first housing is closed against the second housing, as recited in independent claim 23 and similarly recited in dependent claim 11.

The Office Action alleges Kim discloses a second housing hinge section (18) including a light source (19), the second housing hinge section configured to expose the light source external to the mobile communication device when the first housing is closed against the second housing at Fig. 6.

Applicants disagree. Applicants assert that Kim et al. does not disclose a light source that directs light both to a numeric keypad when a second housing is in the open position and external to a mobile communication device when a first housing is closed against the second housing. In fact, Applicants assert the Office Action mischaracterizes the teachings of Kim et al. In particular, Kim et al. expressly discloses that Fig. 6 illustrates a second illuminating lamp 15 that functions as a flash light (col. 4, lines 15-18). The second illuminating lamp 15 does not direct light to a numeric keypad. More particularly, the third illuminating lamp 19 directs light to the key pad 20 (Fig. 7 and col. 4, lines 26-31). Thus, the Office Action is incorrect in alleging the "light source (19)" directs light external to the mobile communication device because Kim et al.

RECEIVED
CENTRAL FAX CENTER

OCT 03 2006

Serial No. 10/766,088

Page 11

clearly discloses only the third illuminating lamp 19 on directs light to the key pad 20 while the second illuminating lamp 15 functions as a flash light. Consequently, Kim et al. does not disclose a light source that directs light both to a numeric keypad when a second housing is in the open position and external to a mobile communication device when a first housing is closed against the second housing.

Leman fails to make up for the deficiencies of Kim et al. and such is not alleged by the Office Action.

Thus, Leman and Kim et al. do not disclose a light source configured to direct light substantially directly at an external visible portion of a mobile communication device numeric keypad when a second housing is in the open position and second housing hinge section configured to expose the light source external to the mobile communication device when a first housing is closed against the second housing, as recited in independent claim 23 and similarly recited in dependent claim 11.

Therefore, Applicants respectfully submit that independent claims 1 and 23 and dependent claim 11 define patentable subject matter. The remaining claims depend from independent claims 1 and 23 and therefore also define patentable subject matter. Accordingly, Applicants respectfully request the withdrawal of the rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103.

CONCLUSION

Applicants respectfully submit this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1-3, 5, 6, 9, 11-14, 16, 17, 19, 21, and 23-26 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

RECEIVED
CENTRAL FAX CENTER

OCT 03 2006

Serial No. 10/766,088

Page 12

The Commissioner is hereby authorized to deduct any fees arising as a result of this Amendment or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

Respectfully submitted,



Matthew C. Loppnow
Attorney for Applicant
Registration No. 45,314

Dated: October 3, 2006

Phone No. (847) 523-2585
Fax No. (847) 523-2350

Please send correspondence to:
Motorola, Inc.
Intellectual Property
600 North U.S. Highway 45
Libertyville, IL 60048